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EXAMINER

PECHHOLD, ALEXANDRA K

ART UNIT	PAPER NUMBER
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3671

DATE MAILED: 01/28/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/912,281

Applicant(s)

ALLARD ET AL.

Examiner

Alexandra K Pechhold

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 22 November 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☐ Claim(s) \_\_\_\_\_ is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,6,10-14 and 27 is/are rejected.
- 7) ☒ Claim(s) 3-5 and 7-9 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 22 November 2002 is: a) ☒ approved b) ☐ disapproved by the Examiner
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☒ Interview Summary (PTO-413) Paper No(s). 11
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. **Claims 1, 2, 6, 10, 11, 14, and 27 are rejected under 35 U.S.C. 102(b) as being anticipated by “Enviropod” (NZ 299114).**

Enviropod discloses an apparatus and a catch basin filtration system comprising:

(a) a filter body seen as filtration means (2) in Fig. 1,

(b) a filter body support seen as cage means (3) in Fig. 1, dimensioned and adapted to cooperatively engage with the inlet and filtration means (2) to substantially maintain the filtration means (2) in a pre-selected position within the inlet,

(c) an initial high flow bypass, seen as outlet (14) in Fig. 1, situated within the cage means (3) and capable of passing excess fluid during periods of high volume fluid flow, and

(d) a secondary high flow bypass, seen as overflow opening (13) in Fig. 1, situated within the filter body support and capable of passing excess fluid during periods of high volume fluid flow, and the overflow opening (13) being separate and distinct from the outlet (14).

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Regarding claim 2, Enviropod discloses that when inflow exceeds outflow, the water level in the bag slowly rises until flow bypasses the filter through the overflow (page 11, lines 10-11). Therefore, fluid will flow through outlet (14) before it overflow through the overflow opening (13).

Regarding claim 6, the outlet (14) of Enviropod can be placed in an desired position, thereby being adjustable. Furthermore, it has been held that the provision of adjustability, where needed, involves only routine skill in the art. *In re Stevens*, 101 USPQ 284 (CCPA 1954).

Regarding claims 10, 11, and 14, Enviropod discloses that the filtration means (2) is made from a geotextile material or nylon or shade cloth, suitable for the filtration of suspended solids from water passing through the material (page 8, lines 6-7). Inherently, the geotextile material or nylon or shade cloth of the filtration means may become displaced as water is filtered therethrough.

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily

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published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

**4. Claims 1, 2, 6, 10-12, 14, and 27 are also rejected under 35 U.S.C. 102(e) as being anticipated by Wilson et al (US 6,093,314).**

Wilson discloses an apparatus and a catch basin filtration system comprising:

(a) a filter body seen as filter (44) in Figs. 1 and 2,

(b) a filter body support seen as outer housing (12) and inner sleeve (32) in Figs. 1 and 2, dimensioned and adapted to cooperatively engage with the inlet and filter (44) to substantially maintain the filter (44) in a pre-selected position within the inlet,

(c) an initial high flow bypass, seen as outlets (30) in Figs. 1 and 2, situated within the outer housing (12) and capable of passing excess fluid during periods of high volume fluid flow, and

(d) a secondary high flow bypass, seen as grating (57) in Fig. 3, situated within the filter body support and capable of passing excess fluid during periods of high volume fluid flow, and the grating (57) being separate and distinct from the outlets (30).

Regarding claim 2, excess water will not flow out of the grate (57) before it flows through outlets (30).

Regarding claim 6, the outlets (30) of Wilson can be placed in an desired position, thereby being adjustable. Furthermore, it has been held that the provision of adjustability, where needed, involves only routine skill in the art. *In re Stevens*, 101 USPQ 284 (CCPA 1954).

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Regarding claims 10 and 14, Wilson discloses one absorbent container within the filter body, seen as filter (44) which is formed of a geotextile fabric capable of absorbing petroleum-based products such as gasoline, oil, grease and the like (Col 5, lines 45-50).

Regarding claim 11, the filter (44) of Wilson is supported by a pair of hooks (46) (see Fig. 4) on one side only, therefore capable of being displaced.

Regarding claim 12, Wilson discloses that one type of filter suitable for use as filter (44) is sold under the name and mark StreamGuard™ by Foss Environmental & Infrastructure of Seattle, Wash (Col 5, lines 47-50). The contents of StreamGuard™ as disclosed in the attached product description

(<http://www.epa.gov/region1/steward/ceitts/stormwater/techs/streamguardskimmer.html>) comprises 3 pounds of hydrocarbon-absorbing polymer contained in a screen pillow, the oleophilic StreamGuard™ polymer media designed not deteriorate or release absorbed hydrocarbons.

### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. **Claim 13 rejected under 35 U.S.C. 103(a) as being unpatentable over Wilson et al (US 6,093,314).** The single filter (44) of Wilson can be viewed as an elongated boom. It would have been obvious to one having ordinary skill in the art at the time the

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invention was made to have more than one boom, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

### ***Allowable Subject Matter***

7. Claims 3-5 and 7-9 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

### ***Response to Arguments***

8. Applicant's arguments filed 11/22/02 have been fully considered but they are not persuasive.

Applicant argues that Enviropod does not disclose an initial high flow bypass situate within a filter body support, and a secondary high flow bypass. Considering the lack of further detail and specification in the claims of what exactly is "bypassed", or how this "bypass" is operating or additional structure thereof, the outlet (14) of Enviropod certainly reads as an initial high flow bypass, since the water will first, initially flow out of the outlet (14) when the water level rises. When the water level reaches the top of the filter device, it has no other means but to flow out of the overflow opening (13), which thereby serves as a secondary high flow bypass. Clearly the overflow opening (13) can represent a "high flow bypass", since during high flow, the water will escape through this

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overflow opening (13). Furthermore, the overflow opening (13) will indeed pass excess fluid only after excess fluid has passed or attempted to pass through the outlet (14).

Regarding the adjustability of the initial high flow bypass in claim 6, applicant disputes examiner's rejection. Yet the examiner maintains that the outlet (14) will be placed in relation to the filter device, or vice versa, for the optimal relationship for hydraulic flow, and is therefore adjustable to the desired height relationship.

Regarding applicant's dispute of examiner's rejection of claim 10, a geotextile, shade cloth, or nylon as disclosed in Enviropod can have the ability to adsorb material, depending on the amount of porosity of the geotextile, shade cloth, or nylon.

Regarding claim 10, applicant argues Enviropod neither discloses nor suggests that its filter bag (2) may be come displaced as water is filtered therethrough. Yet Enviropod discloses on page 8 that the upper end (5) of the filtration means (2) is open and affixed or securable to the support means (4) by means of a steel support ring (6) placed in a sewn loop (7) on top of the bag, and the steel ring (6) sits on a lip (8) built in to the support means (4) as shown in Fig. 3. Therefore, since the upper end of the filtration means (2) where the ring (6) is, merely rests by gravity on the support means (4) and is not permanently affixed, it could inherently be capable of becoming displaced if the filter device becomes so flooded that the hydraulic forces cause the filtration means (2) to displace.

Similarly, applicant argues that the outlet (30) and grating (57) of Wilson cannot be viewed as an initial high flow bypass and a secondary high flow bypass, respectively. Yet the claim language is broad enough that there is no reason that outlet (30) cannot



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be viewed as an initial high flow bypass, since water will overflow there first, and once the drain insert reaches maximum capacity, the water will flow out of the grating at the top, thereby being a secondary high flow bypass. Just because the grate (57) serves as an initial inlet for water is irrelevant to the grate (57) also acting as a secondary high flow bypass, since when the water entirely fills the drain insert, it will spill up through the grate (57). Furthermore, Fig. 2 illustrates the outlet (30) is within a filter body support, which the examiner viewed as outer housing (12) and inner sleeve (32). Regarding the adjustability of outlet (30), the outlets (30) can be placed wherever desired for optimal flow of water out of the drain insert, and therefore are adjustable to the desired position in the outer housing (12). Applicant also argues that the single filter (44) of Wilson cannot be viewed as an elongated boom which the applicant recites in claim 13. Merriam-Webster's Collegiate Dictionary (10<sup>th</sup> Ed.) defines boom as "a temporary floating barrier used to contain an oil spill". The filter (44) of Wilson meets this definition since it is a floating barrier "capable of absorbing petroleum-based products such as gasoline, oil, grease and the like" (Col 5, lines 45-47).

### ***Conclusion***

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

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mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alexandra Pechhold whose telephone number is (703) 305-0870. The examiner can normally be reached on Mon-Thurs. from 8:00am to 5:30pm and alternating Fridays from 8:00am to 4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas B. Will, can be reached on (703)308-3870. The fax phone number for this Group is (703) 305-3597.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1113.

  
Thomas B. Will  
Supervisory Patent Examiner  
Group 3600

AKP  
1/24/03